

Appl. No. : 09/618,765  
Filed : July 18, 2000

## REMARKS

Applicant has the following comments in response to the Office Action.

### Discussion of Claim Rejections Under 35 U.S.C. § § 102(b) and 103(a)

In the Office Action, the Examiner rejected Claims 1-4, 6-8, 11-14, and 16-18 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,473,855, to Welder (hereinafter "Welder"). Claims 5, 9, 15, 19, and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Welder in view of Peterson.

One embodiment of Applicant's system is generally directed to a content delivery service. In one embodiment, executable code in a disk controller circuit in a disk drive is manufactured so as to, under the occurrence of a selected condition, initiate execution of a server-contacting program. The disk controller circuit may delay the initiation of the execution of the server contacting program until a predetermined period has lapsed or, alternatively, it may count the number of times a personal computer associated with the disk drive has been booted. After execution, the server-contacting program uses a network address that is stored in the disk drive to contact a content delivery server. The content delivery server then delivers content to the personal computer.

### Claims 1 and 11

Turning to the claims, it is seen that independent Claim 1, as amended recites: "installing *firmware having disk drive executable code in the disk drive* to initiate execution of the server-contacting program after the disk drive is connected to the computing subsystem in the personal computer system." Independent Claim 11 recites "*a disk controller circuit having disk drive executable code* for initiating execution of the server-contacting program after the disk drive is connected to the computing subsystem in the personal computer system, wherein execution of the server-contacting program includes the using the network address for connecting the personal computer system to the content delivery server."

Applicant respectfully submits that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. See M.P.E.P. § 2131. Applicant respectfully submits that Welder fails to teach or

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suggest at least one limitation from each of independent Claims 1 and 11. In Welder, an initial start-up application (ISUA) is loaded by a basic input output system ("BIOS") in a computer when a computer is first powered up. *See* col. 3, lines 43-50. The computer system may include an initial payload that is presented to the user after a power-on self test ("POST"). *See* col. 4, lines 13-57. The ISUA and the payload may be stored in a non-volatile memory. *See* col. 7, lines 43-55. It is noted that although the ISUA may reside in the disk drive, it is not intended to be executed by the disk drive itself; rather, it is to be loaded for execution by the computer. *See e.g.*, col. 9, lines 6-37.

Applicant respectfully submits that in Welder, it is the POST routine in the BIOS, firmware in the computer itself, that *initiates* execution of a server contacting program. *See* col. 8, lines 11-15, and col. 9, lines 6-37. From a visual inspection of Figure 2 of Welder, it is clear that the non-volatile ram (175) that stores the BIOS is not located in the mass storage device (152). In Welder, a disk controller circuit in the mass storage (152) never initiates on its own the execution the ISUA or other software. Disadvantageously, disk drive manufacturers would not be able to provide a content delivery system under the teachings of Welder, in light of the fact that they do not typically have access to the BIOS firmware of a computer.

Since Welder and Peterson fails to teach or suggest at least the above-limitations, Applicant respectfully submits that independent Claims 1 and 11 are in condition for immediate allowance.

#### Claims 2-10 and 12-20

Since Claims 2-10 and 12-20 each depend on one of Claims 1 and 11, Applicant respectfully submits that these claims are allowable for at least the reasons discussed above and the subject matter of their own limitations.

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Summary

Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is respectfully requested. If the Examiner has any questions which may be answered by telephone, he is invited to call the undersigned directly.

Respectfully submitted,

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